

Appl. No. 10/738,430
Examiner: BALAOING, ARIEL A, Art Unit 2683
In response to the Office Action dated September 22, 2005

Date: December 21, 2005
Attorney Docket No. 10113501

REMARKS

Responsive to the Office Action mailed on September 22, 2005 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Claims 1-4, 6-11, 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakaguchi et al (US 2002/0094841 A1). Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi et al in view of Kao et al (US 2002/0227763 A1).

In this paper, claims 1 and 10 are amended to more clearly recite novel and nonobvious features of the present invention. Support for the amendments can be found in the original claims, Figs. 5a-5c and pages 7-8 of the application. Claims 6, 8, 11, 13 and 16 are amended to correct informalities. New claims 20 and 21 are added. Support for the new claims can be found in Figs. 5a-5c and pages 7-8 of the application. Thus, on entry of this amendment, claims 1-21 are pending in the application.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

Rejections Under 35 U.S.C. 112

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

In this paper, claims 1, 8 and 10 are amended to cancel the language "the outside." Applicant submits that the rejections under 35 U.S.C. 112 are thereby overcome.

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Rejections Under 35 U.S.C. 102(b)

Claims 1-4, 6-11, 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakaguchi et al. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

To anticipate a claim, a reference must teach every element of the claim. In this regard, the Federal Circuit has held:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As amended, claim 1 recites a mobile phone with a SIM card holder comprising a body including a first concave portion and a second concave portion; a holder disposed in the first concave portion of the body, the holder movable between a first position overlapping the second concave portion and a second position not overlapping the second concave portion; and a SIM card removably disposable in the second concave portion of the body, wherein the SIM card is abutted by the holder so that the holder is moved to the second position from the first position during the disposition of the SIM card in the second concave portion, and the holder returns from the second position to the first position so as to fix the SIM card in the second concave portion when the SIM card is located in the second concave portion.

Similarly, amended claim 10 recites a mobile phone with a SIM card holder comprising a body; a holder disposed on the body, the holder movable between a first position and a second position; and a SIM card removably disposable on the body, wherein the SIM card is abutted by the holder so that the holder is moved to the second position from the first position so as not to

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overlap the SIM card during disposition of the SIM card on the body, and the holder returns from the second position to the first position to overlap the SIM card so as to fix the SIM card on the body when the SIM card is located on the body.

Sakaguchi et al teach a SIM card mounting structure of a mobile phone including a SIM card receiving recess for receiving the SIM card and a pressing portion. One end of the pressing portion is integral with receiving recess, while the other end functions as a leaf spring elastically pressing the SIM card received in the recess. See Figs. 1A-2B and paragraph 0028 of Sakaguchi et al.

Sakaguchi et al do not teach or suggest a holder disposed in the first concave portion of the body, the holder movable between a first position overlapping the second concave portion and a second position not overlapping the second concave portion, as recited in claim 1.

As disclosed by Sakaguchi et al, the pressing portion is fixed to one side of the receiving recess and permanently overlaps a portion of the receiving recess. Thus, Sakaguchi et al do not teach that the pressing portion is movable between a first position and a second position, where the pressing portion is not overlapping the receiving recess when in the second position.

Sakaguchi et al do not teach or suggest the SIM card is abutted by the holder so that the holder is moved to the second position from the first position during the disposition of the SIM card in the second concave portion, as recited in claim 1.

Claim 1 recites that when the holder is in the first position, it is overlapping the second concave portion, and when the holder is in the second position, it is not overlapping the second concave portion. Claim 1 further recites that the holder is moved to the second position from the first position during the disposition of the SIM card in the second concave portion.

In contrast, during disposition of the SIM card into the receiving recess of Sakaguchi et al, the pressing portion is not moved from a position overlapping the receiving recess to a position not overlapping the receiving recess. To the contrary, the pressing portion is always overlapping the receiving recess.

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Sakaguchi et al do not teach or suggest the SIM card is abutted by the holder so that the holder is moved to the second position from the first position so as not to overlap the SIM card during disposition of the SIM card on the body, as recited in claim 10.

During disposition of the SIM card in the receiving recess of Sakaguchi et al, the pressing portion may be moved by the abutment of the pressing portion and the SIM card. However, in the structure described by Sakaguchi et al, the pressing portion must be overlapping the SIM card for the pressing portion to be moved thereby. Namely, during the disposition of the SIM card into the receiving recess, the SIM card is inserted under the pressing portion.

Thus, in Sakaguchi et al, the pressing portion is not moved to a second position from a first position so as not to overlap the SIM card during disposition of the SIM card on the mobile telephone.

Sakaguchi et al do not teach or suggest the holder returns from the second position to the first position to overlap the SIM card so as to fix the SIM card on the body when the SIM card is located on the body, as recited in claim 10.

As the pressing portion is never moved to a second position not overlapping the SIM card by the abutment of the SIM card and the pressing portion, it follows that the pressing portion cannot return from the second position to a first position to overlap the SIM card so as to fix the SIM card on the mobile telephone when the SIM card is located on the mobile telephone.

For at least the reasons described above, it is Applicant's belief that Sakaguchi et al fail to teach or suggest all the limitations of claims 1 and 10. Applicant therefore respectfully requests that the rejections of claims 1 and 10 be withdrawn and the claims passed to issue. Insofar as claims 2-9 and 12-21 depend from claim 1 or 10 either directly or indirectly, and therefore incorporate all of the limitations of claim 1 or 10, it is Applicant's belief that these claims are also in condition for allowance.

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Rejections Under 35 U.S.C. 103(a)

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi et al in view of Kao et al.

As noted above, it is Applicant's belief that claims 5 and 12 are allowable by virtue of their dependency from claim 1 or 10. For this reason, the Examiner's arguments in connection with these claims are considered moot and will not be addressed here.

New Claims 20-21

As noted above, it is Applicant's belief that claims 20 and 21 are allowable by virtue of their dependency from claim 1 or 10. Furthermore, Applicant submits that the references relied upon by the Examiner fail to teach or suggest that the body includes an abutting surface between the first concave portion and the second concave portion, and the holder includes an elastic portion corresponding to the abutting surface, wherein the elastic member is compressed against the abutting surface by movement of the holder from the first position to the second position, and elastic force from the compressed elastic member returns the holder from the second position to the first position when the holder is released while in the second position, as recited in claims 20 and 21.

Foreign Priority Claim

Acknowledgment of Applicant's claim to foreign priority under 35 USC 119(a)-(d) or (f) and receipt of the certified copies of the priority document(s) is respectfully requested.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,

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